

## REMARKS

### Rejection Under 35 U.S.C. § 102(e)

In the Office Action, claim 1 was rejected under 35 U.S.C. § 102(e) as being anticipated by United States Patent No. 6,214,351, herein referred to as Wadsworth. In re Robertson, 169 F.3d 743, 745, 49 U.S.P.Q.2d (BNA) 1949 (Fed. Cir. 1999) provides, “[a]nticipation under 35 U.S.C. § 102(e) requires that each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” Further, Toro Co. v. John Deere & Co., LEXIS 8272, p.10 (D. Minn. 2001) provides “a claim is anticipated if each and every limitation found in the claim is either explicitly or inherently found in a single prior art reference.” “To prove anticipation when the prior art reference is silent about the asserted inherent characteristic, it must be clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by one of ordinary skill in the art.” Id. at 12.

Although the Examiner asserts that claim 1 is anticipated by Wadsworth, Applicants respectfully disagree. Wadsworth teaches “the *Morinda citrifolia* seed oil may be used in, but is not limited to massage oil, cosmetics, candles, and as a product by itself.” (Column 3, lines 40-42.) A disclosure that *Morinda citrifolia* seed oil may be used in cosmetics is not a proper 35 U.S.C. § 102(e) rejection because Wadsworth does not teach each and every element of the claimed invention. For example, Wadsworth does not teach that the *Morinda citrifolia* seed oil is to be present in an amount between about 0.1% to 20% by weight. Accordingly, Wadsworth does not teach one skilled in the art how to make and use the claimed invention. Moreover, the mere disclosure that *Morinda citrifolia* seed oil may be used in cosmetics does not provide a disclosure that is enabling.

Accordingly, Applicants respectfully submit that claim 1 overcomes the rejection made by the Examiner under 35 U.S.C. § 102(e).

*Rejection Under 35 U.S.C. § 103(a)*

In the Office Action, claims 1-7, 11-12, 14-19, 22, 24, and 27 were rejected by the Examiner under 35 U.S.C. § 103(a) as being unpatentable over Krog et al. (United States Patent No. 5,945,092, hereinafter Krog) in combination with Wadsworth. The Examiner also rejected claims 1-18, 20, and 22-27 under 35 U.S.C. § 103(a) as being unpatentable over Lane (United States Patent No. 5,503,825, hereinafter “Lane”) in combination with Wadsworth. The Examiner also rejected claim 21 under 35 U.S.C. 103(a) as being unpatentable over Lane or Krog in combination with Wadsworth and in further view of McGinity et al. (United States Patent No. 5,597,849, hereinafter “McGinity”).

Wadsworth teaches of an essential oil product obtained from the Indian mulberry (*Morinda citrifolia*) plant and the process of extracting and purifying the oil. According to one embodiment, the seeds from the Indian mulberry fruit are dried, preferably to a moisture content less than 10%. The seeds are ground or shredded to facilitate the removal of natural occurring oil. The shredded or ground flakes are pressed to expel *Morinda citrifolia* oil. The remaining seed cake is then mixed with a food grade, non-polar extraction solvent such as hexane. The mixture is heated for a sufficient length of time to complete the extraction process. The extraction solvent is then evaporated from the mixture leaving the *Morinda citrifolia* oil. The oil is further refined, bleached, dried, and deodorized to remove free fatty acids and other unwanted components. An antioxidant can optionally be added to stabilize the oil for further processing or packaging. (Abstract.)

Lane discloses a topical composition having improved healing properties, and particularly a lip balm for healing chapped, cracked, sunburned and windburned lips, and comprising up to 35 wt % aloe vera; 3 wt % or more salt; and a pharmaceutically acceptable topical medium.” (Abstract.)

Krog discloses an anhydrous cosmetic stick composition with improved transfer resistance comprising, by weight of the total composition: a) 10-70% of a volatile solvent b) 0.1-40% of a polymeric organosiloxane emulsifier containing at least one hydrophilic radical and at least one lipophilic radical.” (Abstract.)

McGinity discloses stick formulations for topical delivery of water soluble and/or water insoluble agents. The stick formulations may contain steroids, antibiotics, antifungal, antihistamines anti inflammatories or local anesthetics. The vehicles comprise a combination of waxes and oils and a surfactant in embodiments involving water soluble agents. Methods for preparing the various stick formulations are also disclosed. (Abstract.)

In contrast, the claimed invention provides a lip treatment and a method for manufacturing the lip treatment, wherein the lip treatment serves to provide significant help in lip care advantages over the references cited by the Examiner. For example, none of the references teach the inclusion of linoleic acid, which has specific abilities for nourishing the health of lips.

The references cited by the Examiner also do not include the limitation of xeronine. With reference to page 12, lines 12-14, the present invention teaches that xeronine assists in enlarging the membrane pores of the cells. This enlargement allows for larger chains of peptides (amino acids or proteins) to be admitted into the cell. Xeronine assists in enlarging the pores to allow better absorption of nutrients. Accordingly, the inclusion of xeronine enhances the lip treatment by

providing increased absorption of nutrients from the lip treatment to the cells of the lip. This limitation is not taught in any of the references cited by the Examiner.

Accordingly, Applicants respectfully submit that for at least these reasons, the references cited in the Office Action by the Examiner do not anticipate, teach, nor render obvious the present invention as provided in the claim set herein. Furthermore, Applicants respectfully submit that the amended claim set as provided herein overcomes all rejections made in the Office Action by the Examiner.

#### CONCLUSION

Based on the foregoing, Applicants submit that the grounds for Examiner's rejections have been removed, and in light of the amendments and remarks, the present invention is not, anticipated, disclosed, nor rendered obvious by the prior art references. Accordingly, the application is now in a condition for allowance and Applicants respectfully request the same.

Should the Examiner have any questions, comments, or suggestions in furtherance of the prosecution of this application, the Examiner is invited to initiate a telephone interview with undersigned counsel.

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VERSION SHOWING CHANGES MADE

1. A lip treatment comprising:

*Morinda citrifolia* seed oil present in an amount between about 0.1-20 percent by weight;

and

at least one of:

- (i) linoleic acid; and
- (ii) xeronine.

2. (cancel)

3. (cancel)

4. (cancel)

5. (cancel)

6. The lip treatment of claim 1, further comprising *Morinda citrifolia* fruit juice present in an amount between about 0.1-50 percent by weight.

7. The lip treatment of claim 1, further comprising at least one of:

- (i) dimethicone present in an amount between about 1-5 percent by weight[.];
- (ii) octyl salicylate present in an amount between about 1-5 percent by weight;

- (iii) oxybenzone present in an amount between about 1-5 percent by weight;
- (iv) cetyl alcohol present in an amount between about 1-5 percent by weight;
- (v) squalane present in an amount between about 1-5 percent by weight;
- (vi) butylated hydroxytoluene present in an amount between about 1-5 percent by weight;
- (vii) beeswax present in an amount between about 1-5 percent by weight;
- (viii) phenyl trimethicone present in an amount between about 1-5 percent by weight;
- (ix) benzophenone-3 present in an amount between about 1-5 percent by weight;
- (x) sorbitan oleate present in an amount between about 1-5 percent by weight;
- (xi) a wax derivative present in an amount between about 1-5 percent by weight;
- (xii) isopropyl lanolate present in an amount between about 1-5 percent by weight;  
and
- (xiii) isocetyl stearate present in an amount between about 1-5 percent by weight;

8. The lip treatment of claim 1, further comprising at least one of:

- (i) octyl methoxycinnamate present in an amount between about 5-10 percent by weight;
- (ii) lanolin present in an amount between about 5-10 percent by weight;
- (iii) paraffin present in an amount between about 5-10 percent by weight; and
- (iv) isopropyl myristate present in an amount between about 5-10 percent by weight.

9. (cancel)

10. (cancel)

11. The lip treatment of claim 1, further comprising petrolatum present in an amount between about 20-80 percent by weight.

12. The lip treatment of claim 1, further comprising ozokerite present in an amount between about 5-20 percent by weight.

13. (cancel)

14. (cancel)

15. (cancel)

16. (cancel)

17. (cancel)

18. (cancel)

19. (cancel)

20. (cancel)

21. (cancel)

22. The lip treatment of claim 1, further comprising white petrolatum present in an amount between about 40-70 percent by weight.

23. (cancel)

24. (cancel)

25. (cancel)

26. (cancel)

27. The lip treatment of claim 1, further comprising ingredients selected from the group consisting of Menthol, Myristyl Lactate, Myristyl Myristate, Octyl Palmitate, Vitamin E, Avocado Oil, Cetyl Alcohol, Chamomile Oil, Isopropyl Lanolate, Microcrystalline Wax, Propylparaben, Shea Butter, Zinc Oxide, Aloe Vera Extract, Methylparaben, Jojoba Oil and, Fragrance, Cetyl Alcohol, Aloe Extract, Methylparaben, Propylparaben, Vitamin E Acetate, Vitamin E Linoleate, Sodium

Saccharinate, Sweet Almond Oil, Macadamia Ternifolia (Nut) Seed Oil, Kukui Nut Oil, Shea Butter, Camphor Gum, Menthol, Tocopheryl Acetate (Vitamin E Acetate), Propylparaben, and Flavor, each present in an amount between about 0-1 percent by weight.

Please add the following new claims:

28. A method for manufacturing a lip treatment, the method comprising the steps for: providing a carrier composition; combining the carrier composition with *Morinda citrifolia* seed oil present in an amount between about 0.1% to 20% by weight and at least one of:

- (i) linoleic acid; and
- (ii) xeronine to obtain a resulting combination; and

providing the resulting combination in a container to allow for a selective application of the resulting combination on to a lip of a user.

29. A method as recited in claim 28, wherein the carrier composition comprises at least one of:

- (i) petrolatum;
- (ii) ozokarite;
- (iii) octyl methoxycinnamate;
- (iv) cobitan oleate;
- (v) benzophenone-3;
- (vi) bees wax;

- (vii) paraffin;
- (viii) canola oil;
- (ix) shea butter;
- (x) propylparaben;
- (xi) tocopheryl acetate;
- (xii) sweet almond oil;
- (xiii) macadamia ternfolia seed oil;
- (xiv) kukui nut oil;
- (xv) fragrance;
- (xvi) butylated hydroxyanisole;
- (xvii) propyl gallate; and
- (xviii) citric acid.

30. A method as recited in claim 28, further comprising the step for providing the resulting combination in the form of one of:

- (i) a lip balm;
- (ii) a lip ointment;
- (iii) a lipstick; and
- (iv) a lip gloss.